

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:)	Mail Stop: Appeal Brief-Patents
)	
Steven L. PURCELL)	Group Art Unit: 3671
)	
Application No.: 10/786,298)	Examiner: Tara L. Mayo
)	
Filed: February 26, 2004)	
)	
For: MICRO TRENCH DUCT)	
PLACEMENT)	

REPLY BRIEF UNDER 37 CFR § 41.41

U.S. Patent and Trademark Office
Customer Window, Mail Stop: Appeal Brief-Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This reply brief is submitted in response to the Examiner's Answer, mailed May 26, 2006.

In response to the "Response to Arguments" section of the Examiner's Answer (pages 11-12), Appellant submits the following remarks.

In section A of the "Response to Arguments," the Examiner's Answer addresses the rejection of claims 1-4, 7, 11 and 12 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,371,691 (hereinafter "FINZEL"). In this section, the Examiner's Answer, in

response to Appellant's assertion in the Appeal Brief that FINZEL fails to disclose "pulling the first cable out of, and through, the duct," alleges that a "broad and reasonable interpretation of the claim limitation does not require the entire length of cable to be completely pulled through and out of the end of the duct." The Examiner's Answer further alleges that "pulling the first cable out of the duct merely requires the cable to be drawn until its end extends beyond the end of the duct and is inherent to the system shown by" FINZEL and that "[o]therwise, the cable would be of no use because its end would be inaccessible for subsequent connection."

Appellant respectfully submits that the Examiner's interpretation of the invention recited in claim 1 is not a reasonable interpretation. During patent examination, claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). See also M.P.E.P. § 2111. The broadest reasonable interpretation of the claims must be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999). See also M.P.E.P. § 2111. Claim 1, among other features, recites "placing a first cable within the duct" and "pulling the first cable out of, and through, the duct." As noted above, the Examiner's Answer asserts that FINZEL inherently discloses placement of the cable within the duct by pulling the cable through the duct, with an end portion of the cable extending out of the duct to be accessible for connection. The Examiner's Answer further asserts that this inherent disclosure of FINZEL teaches "pulling the first cable out of, and through, the duct," as recited in claim 1. The Examiner, thus, appears to be

effectively interpreting claim 1 in the following manner: “placing a first cable within the duct, wherein placing the first cable comprises pulling the first cable out of, and through, the duct.” In contrast to the Examiner’s effective interpretation of claim 1, two separate steps are actually recited in claim 1: 1) placing a first cable within the duct; and 2) pulling the first cable out of, and through, the duct. Appellant submits that a reasonable interpretation of the claim 1, therefore, is that a cable is first placed in the duct and then the cable is pulled out of the duct so that a second cable can be placed in the duct. An interpretation of claim 1, as alleged by the Examiner’s Answer, that improperly conflates the cable placement step with the cable removal process ignores the two separate steps recited in claim 1 and, thus, is not a reasonable interpretation that would be consistent with an interpretation that those skilled in the art would reach.

In section B of the “Response to Arguments,” the Examiner’s Answer asserts that Appellant has not separately addressed the rejection of claims 6 and 13 and, therefore, that claims 6 and 13 should stand or fall with claim 1. Appellant does not object to claims 6 and 13 standing or falling with claim 1.

In section C of the “Response to Arguments,” the Examiner’s Answer asserts that Appellant has stated that U.S. Patent Application Publication No. 2003/0068143 (hereinafter “MARTINEZ”) is “nonanalogous art.” To rebut this alleged statement by Appellant, the Examiner’s Answer asserts that MARTINEZ “directly relates to the process of installing fiber

optic cables in a previously buried duct less the step of removing any material overlying the buried duct.” The Examiner’s Answer further directs Appellant to review paragraph 0010 of MARTINEZ which allegedly “expressly teaches the desirability of using previously buried ducts to obviate the inconvenience of surface disturbance.” Appellant submits that Appellant’s appeal brief did not argue that MARTINEZ is “nonanalogous art” as asserted by the Examiner’s Answer. Appellant’s appeal brief argued that the final Office Action did not provide a sufficient reason, suggestion, or motivation for combining the disclosure of MARTINEZ with the disclosure of FINZEL. Appellant respectfully directs the Examiner to pages 11 and 12 of the Appeal Brief, which also addresses paragraph [0010] cited by the Examiner’s Answer, for Appellant’s arguments with respect to the final Office’s Action’s failure to provide a sufficient motivation for combining MARTINEZ with FINZEL.

In section D of the “Response to Arguments,” the Examiner’s Answer asserts that Appellant has not separately addressed the rejection of claims 8-10 and, therefore, that claims 8-10 should stand or fall with claim 1. Appellant does not object to claims 8-10 standing or falling with claim 1.

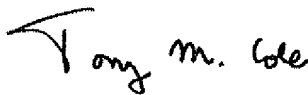
In section E of the “Response to Arguments,” the Examiner’s Answer asserts that Appellant has not separately addressed the rejection of claims 25 and 26 and, therefore, that claims 25 and 26 should stand or fall with claim 23. Appellant does not object to claims 25 and 26 standing or falling with claim 23.

CONCLUSION

In view of the foregoing arguments, Appellant respectfully solicits the Honorable Board to reverse the outstanding rejections of claims 1-4, 6-13, 23-26, 28, 29, 31 and 32.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,



By: _____
Tony M. Cole
Reg. No. 43,417

Date: July 18, 2006

Harrity Snyder, L.L.P.
11350 Random Hills Road
Suite 600
Fairfax, Virginia 22030
Main: (571) 432-0800
Direct: (386) 575-2713

Customer Number: 25537